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EXAMINER	
SANTIAGO, MARICELI	

ART UNIT	PAPER NUMBER
2879	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/586,404	LI, JIN	
	Examiner	Art Unit	
	Mariceli Santiago	2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 July 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Receipt of the Amendment, filed on July 16, 2010, is acknowledged.

Cancellation of claims 1-18 has been entered.

Claims 19-30 are pending in the instant application.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "1" and "3" have both been used to designate “the light body”, although the specification states a fluorescent layer “3”, the drawings fail to show and designate the reference "3" to a fluorescent layer since the reference number merely points to an inner surface of the light body. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they

must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 29 and 30 (at Page 4) have been renumbered 33 and 34.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 19, recites “said fluorescent layer which is arranged to coat *throughout*[1] an inner surface of said light body”, however, the limitation has not been described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The specification merely states “a fluorescent layer coated onto an inner cavity of the light body 1”, and fails to explicitly state "is arranged to coat *throughout* an inner surface of said light body”. Furthermore, the drawings fails to show the claimed limitation, particularly, the drawings fail to show and designate the reference "3" to a fluorescent layer since the reference number merely points to an inner surface of the light body. It has been held, that drawings accompanying the application are merely illustrative of principles embodied in the alleged invention claimed therein and do not

[1] Defined as: in or to every part of; everywhere in.

define precise proportions elements relied upon to endow claims with patentability, see *In re Olson* (CCPA) 101 USPQ 401. Thus, the reference number "3" pointing to an inner surface of the light body cannot be construed as to show a "fluorescent layer which is arranged to coat *throughout* an inner surface of said light body" but to merely imply, as best understood by the examiner, the presence of a fluorescent coated onto an inner cavity of the light body.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (JP 2003-109547 A) in view of Kling (US 6,175,197), in view of Borowiec (EP 646941 A1), and further in view of Anderson (GB 1555096 A).

Regarding claim 19, Yamamoto discloses a magnetic light, comprising: an air-filled light body (1) having an inner cavity, at least a through slot (5a) defined on said inner cavity, a fluorescent layer coated onto said inner cavity (¶[0019]), the fluorescent layer is arranged to coat an inner surface of said light body inside said inner cavity, and a magnetic body (2a) positioned in said through slot of said inner cavity, and is arranged to generate high frequency resonance toward said fluorescent layer (4) coated on said inner cavity (Fig. 2), wherein said fluorescent layer (4), after said high frequency resonance, is then arranged to generate illumination (¶[0023]), whereby said fluorescent layer (4) is arranged to coat an inner surface of said light body (1) inside said inner cavity.

Yamamoto fails to explicitly state said fluorescent layer is arranged to coat throughout an inner surface of said light body inside said inner cavity. However, Anderson exemplifies a magnetic lamp provided with an air-filled light body having an inner cavity and a fluorescent layer (20) coated throughout an inner surface of said light body (Fig. 2), provision of the fluorescent layer over the entire inner surface of the light body is known to increase the surface area of the phosphor, thus, an enhance uniform emission of light is obtained. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate a fluorescent layer arranged to coat throughout an inner surface of said light body inside said inner cavity as taught by in the magnetic light of Yamamoto in order to increase the surface area of the phosphor and provide enhanced uniform emission of light.

In regards to the recitation "whereby said fluorescent layer which is arranged to coat an inner surface of said light body inside said inner cavity is capable of illumination throughout said entire surface of said light body", it has been held that the recitation of an element being capable of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Yamamoto exemplifies a fluorescent layer covering the inner surface of the inner cavity as such it has the ability of illumination throughout said entire surface of said light body.

The recitation "arranged to generate illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability," is considered a functional limitation, i.e., applicant is claiming the invention based on what it does rather that by what it is. It is elementary that mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an

inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 169 USPQ 226 (CCPA 1971).

Yamamoto fails to exemplify the limitation of a glass tube communicated with said inner cavity for storing a predetermined amount of mercury and an air guiding tube. Kling discloses a magnetic light which is further provided with a glass tube (72) in communication with an inner cavity of an air-filled light body (12) and an air guiding tube (70), wherein the glass tube (72) is provided with an amalgam (104, Column 5, lines 13-18) in order to control the mercury vapor pressure during operation of the lamp. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Kling in order to control the mercury vapor pressure during operation of the lamp.

Yamamoto in view of Kling fails to exemplify the limitation of the glass tube extended into said inner cavity and communicated with said inner cavity for storing a predetermined amount of mercury. Borowiec discloses a magnetic light (Fig. 3) which is further provided with a glass tube (52) extending into and in communication with an inner cavity of an air-filled light body (12), the glass tube (52) is provided with an amalgam (34) in order to control the mercury vapor pressure during operation of the lamp, furthermore, the glass tube is extended into said inner cavity in order to control position of the amalgam within the inner cavity thus providing better operating temperature control of the amalgam. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Boroweic in order to control the mercury vapor pressure during operation of the lamp and position of the amalgam within the inner cavity.

Regarding claim 26, Yamamoto discloses a magnetic light, comprising: an air-filled light body (1) having an inner cavity, at least a through slot (5a) defined on said inner cavity, a fluorescent layer (4) coated onto said inner cavity (¶[0019]), and a magnetic body (2a) penetrated[2] through said through slot of said inner cavity into position, is arranged to generate high frequency resonance (¶[0023]) such that illumination is generated through said fluorescent layer in said inner cavity of said light body.

The recitation "such that illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability," is considered a functional limitation, i.e., applicant is claiming the invention based on what it does rather that by what it is. It is elementary that mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 169 USPQ 226 (CCPA 1971).

Yamamoto exemplifies the presence of mercury within the inner cavity of the magnetic lamp, however, fails to exemplify the limitation of a glass tube communicated with said inner cavity for storing a predetermined amount of mercury and an air guiding tube. Kling discloses a magnetic light which is further provided with a glass tube (72) in communication with an inner cavity of an air-filled light body (12) and an air guiding tube (70), wherein the glass tube (72) is provided with an amalgam (104, Column 5, lines 13-18) in order to control the mercury vapor pressure during operation of the lamp. Thus, it would have been obvious at the time the

[2] to pass into or through

invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Kling in order to control the mercury vapor pressure during operation of the lamp.

Yamamoto in view of Kling fails to exemplify the limitation of the glass tube extended into said inner cavity and communicated with said inner cavity for storing a predetermined amount of mercury. Borowiec discloses a magnetic light (Fig. 3) which is further provided with a glass tube (52) extending into and in communication with an inner cavity of an air-filled light body (12), the glass tube (52) is provided with an amalgam (34) in order to control the mercury vapor pressure during operation of the lamp, furthermore, the glass tube is extended into said inner cavity in order to control position of the amalgam within the inner cavity thus providing better operating temperature control of the amalgam. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Boroweic in order to control the mercury vapor pressure during operation of the lamp and position of the amalgam within the inner cavity.

Regarding claims 20 and 27, Yamamoto discloses a magnetic light wherein said light body has a through slot disposed at one end of said light body (Fig. 1).

Regarding claims 21 and 28, Yamamoto discloses a magnetic light wherein said light body has a pair of through slots respectively disposed at opposite ends of said light body (Fig. 3).

Regarding claims 22, 23, 29 and 30, Yamamoto discloses a magnetic light wherein said light body is selected from a group consisting of round shape body, oblate shape body, rectangle shape body, cylinder shape body, elliptical shape body, flat panel body, ring shape body and tubular shape body (Fig. 1).

Regarding claims 24 and 25, Yamamoto discloses a magnetic light wherein said through slot is selected from a group consisting of light body is selected from a group consisting of round shape slot, oblate shape slot, rectangle shape slot, and polygonal shape slot (Fig. 1).

Claims 26, 27, 29, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita et al. (JP 2001-006624 A) in view of Kling (US 6,175,197), and further in view of Borowiec (EP 646941 A1).

Regarding claim 26, Miyashita discloses a magnetic light (Figs. 1-2), comprising: an air-filled light body (2) having an inner cavity (9), at least a through slot defined on said inner cavity, a fluorescent layer coated onto said inner cavity (¶[0016]), and a magnetic body (4) penetrated through said through slot of said inner cavity into position, is arranged to generate high frequency resonance (¶s[0019-0020]) such that illumination is generated through said fluorescent layer in said inner cavity of said light body.

The recitation "such that illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability," is considered a functional limitation, i.e., applicant is claiming the invention based on what it does rather that by what it is. It is elementary that mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 169 USPQ 226 (CCPA 1971).

Miyashita exemplify the presence of mercury within the inner cavity of the magnetic lamp, however, fails to exemplify the limitation of a glass tube communicated with said inner cavity for storing a predetermined amount of mercury and an air guiding tube. Kling discloses a magnetic light which is further provided with a glass tube (72) in communication with an inner cavity of an air-filled light body (12) and an air guiding tube (70), wherein the glass tube (72) is provided with an amalgam (104, Column 5, lines 13-18) in order to control the mercury vapor pressure during operation of the lamp. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Kling in order to control the mercury vapor pressure during operation of the lamp.

Miyashita in view of Kling fails to exemplify the limitation of the glass tube extended into said inner cavity and communicated with said inner cavity for storing a predetermined amount of mercury. Borowiec discloses a magnetic light (Fig. 3) which is further provided with a glass tube (52) extending into and in communication with an inner cavity of an air-filled light body (12), the glass tube (52) is provided with an amalgam (34) in order to control the mercury vapor pressure during operation of the lamp, furthermore, the glass tube is extended into said inner cavity in order to control position of the amalgam within the inner cavity thus providing better operating temperature control of the amalgam. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Boroweic in order to control the mercury vapor pressure during operation of the lamp and position of the amalgam within the inner cavity.

Regarding claim 27, Miyashita discloses a magnetic light wherein said light body has a through slot disposed at one end of said light body (Fig. 1).

Regarding claim 29, Miyashita discloses a magnetic light wherein said light body is selected from a group consisting of round shape body, oblate shape body, rectangle shape body, cylinder shape body, elliptical shape body, flat panel body, ring shape body and tubular shape body (Fig. 1).

Regarding claims 31 and 33, Miyashita discloses a magnetic light wherein said through slot is selected from a group consisting of light body is selected from a group consisting of round shape slot, oblate shape slot, rectangle shape slot, and polygonal shape slot (Fig. 1).

Response to Arguments

Applicant's arguments with respect to claims 19-25 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

The rejections above rely on the references for all the teachings expressed in the text of the references and/or one of ordinary skill in the art would have reasonably understood or implied from the texts of the references. To emphasize certain aspects of the prior art, only specific portions of the texts have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combinations of the cited references may be relied on in future rejections in view of amendments.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariceli Santiago whose telephone number is (571) 272-2464. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (571) 272-2457. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mariceli Santiago/
Primary Examiner, Art Unit 2879